

REMARKS

The Examiner is thanked for his allowance of claims 1-13 and 15-22. The Examiner is also thanked for his indication of allowable subject matter of claim 25 over the prior art of record.

The Examiner is also thanked for his careful study of the language of the claims and the remarks which accompanied the prior response to the Office Action. Applicant's attorney has made an effort to correct all wording and typographical error in the claims and believes they are now in condition for final presentation and allowance.

Applicant notes that on page 15, paragraph 15 the Examiner indicated that claim 27 was allowable. On the other hand, in paragraph 11, page 11, the Examiner rejected claim 27 over Brown in view of Seiber et al. Applicant therefore believes that the allowable claim which was intended was claim 37. Applicant also notes that claim 37 has subject matter similar to claim 25.

Submitted herewith is new claim 65 which contains generally the subject matter of claim 25 combined with claim 23 and new claim 66 which includes generally the subject matter of claim 37, slightly edited so as to be compatible with the features of claim 58.

Summary of the Invention

The present invention is directed toward a knife which may be easily opened with one hand. The issued patent, which contains the text of the application as originally filed states, in column 5, lines 8-22, the advantages of the present knife. Within this paragraph, the inventor clearly states that the design and engagement members, such as pin 63 of the knife allows the opening of the blade by the user with one hand.

The ability to open a knife with a single hand is an extremely useful feature. Many times a user will wish to cut a rope while holding one end of the rope tight with one hand. With prior art pocket knives, the user is required to grasp the pocket knife with both hands, using one hand to hold the handle and the other hand to grasp the blade in order to open the knife. Therefore, in the prior art, a user required two free hands in order to open the knife. The user

would not be able to hold a rope or other item with one hand since both hands are required to open the knife.

According to the invention of the '927 patent as described in column 5, a user may grasp the knife in a single hand, and using a thumb of the same hand push on the pin 63' to begin to open the blade and, once the blade is opened a short distance, the biasing member 90, also referred to as a spring 90, will exert a force to open the blade the rest of the way. Alternatively, a user may grip the teeth engagement portions C at the end of the tang as shown in Figures 5A-5C and, by pulling a finger downward, open the blade with one hand a sufficient distance that the spring 90 takes over and pushes the blade open the rest of the distance.

Accordingly, a user may hold a rope in one hand, reach into their pocket with the other hand, remove the knife of the present invention, and then cut the rope without having to let go with their hand. This is extremely convenient and has not been possible with any legal knives of the prior art.

Applicant also points out that the current knife is legal under federal law and is not classified as a switchblade or an automatic knife. In particular, a user of the inventive knife is required to open the knife partially with one hand, using their own manual power. The spring acts to hold the knife in the closed position. It is of substantial benefit that the spring exerts a holding force on the blade while it is in the closed position. The blade is biased to be held by the force of the spring in the closed position so that it does not come loose and there is no movement of the blade when it is closed. The user must manually move the blade at least some distance, overcoming the spring force, until the blade is opened sufficient that the spring force will apply an opening force instead of a closing force. Once the blade has been opened sufficient that the bias element exerts an opening force, only then will the knife open the rest of the way under the power of the spring. Until that point, the user is required to apply manual force to open the blade. The knife is therefore legal to sell in the United States and is not considered a switchblade. Such knives have become extremely popular in recent years and have been a large reason for the resurgence of the popularity of pocket knives.

Response to Rejection Under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 58-64 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Namely, it is the Examiner's view on page 3 that since claims 58-64 contain the phrase "a biasing element" that the application as filed does not provide sufficient support for this phrase.

Applicant disagrees. As a first point, applicant points out that in the application as originally filed there is only a single biasing element: spring 90. The remainder of the plunger assembly E cannot be considered as biasing elements. The shaft 80 is not a biasing element; it has no spring properties. The free end 81 is not a biasing element. The clevis 82 is not a biasing element. Indeed, no other component inside the knife is a biasing element: only the spring 90. Applicant, therefore, submits that there is sufficient disclosure that the biasing element is a single spring element and that a combination of many components to make up a biasing assembly is not required within the written description. Indeed, in the written description as originally filed there is a clear description that it is the spring 90 which provides the biasing force to open the blade.

Applicant therefore submits that there is a clear description in the application as filed which shows possession of the invention.

There is a second reason applicant believes the original disclosure supports a spring as a biasing element. Applicant refers to the Examiner's reasoning and rejection of claim 58. On page 7, under paragraph 7, the Examiner referred to Brown as having a biasing element. The Examiner referred to this biasing element as being the spring 8. Accordingly, for purposes of showing that the biasing element was found in the prior art, the Examiner relied solely on a spring. The Examiner did not require or even state that the biasing element of the prior art needed to have a plunger assembly or a first coupling element or a second coupling element. Indeed, within the prior art, the Examiner believed that the spring alone was sufficient to teach the biasing element.

In order to be consistent, applicant believes that meaning of biasing element for claims 58-64 should be the same for the purposes of section 112 as for section 102. Since it is clear that the Examiner considers that the biasing element can be a single spring for purposes of

the prior art comparison, therefore, the application as filed, showing spring 90 should also be accepted as sufficient for supporting the written description that the biasing element is a spring. The attorney accepts that the spring of Brown is a biasing element and relies on other subject matter to define over the prior art.

This is yet a second reason, beyond the first reason, why applicant believes that the biasing element as present currently in claims 58-64 is adequately disclosed in the application as filed and there is full compliance with the written description requirement for a biasing element.

Response to Rejections Based on Prior Art

It was the Examiner's view that claim 23 is found in the prior art of Brown, U.S. Patent No. 1,864,011. Applicant has amended claim 23 and believes it is clearly patentable in light of the prior art to Brown and all other prior art of record. Claim 23, as amended, specifies that the plunger, which includes a spring, has a first end pivotally coupled to the blade and a second end pivotally coupled to the handle. Of course, Brown does not have such a construction. Indeed, such a construction is foreign to Brown and renders Brown nonoperational. In Brown, the spring 8 is longitudinally extending and is in line with the handle. It is pinned at 2 and 4, and thus cannot pivot about any end. Certainly, the spring 8 can only travel in the longitudinal direction, and even if 3 can be considered a plunger, it cannot pivot about the blade and also pivot about the handle at a second end. In addition, the plate 3 is actually connected through six separate pins to the handle, as can be seen in Figures 1 and 3 of Brown. Accordingly, it is of course would be impossible for the plate 3, which the Examiner refers to as a plunger, to pivot about both a first end and a second. Claim 23 should therefore be allowable over the art of record.

Claim 45 is patentable over Brown based on the definition of the plunger as required within claim 45. Namely, claim 45 clearly states that "a portion of the plunger remains a fixed distance from the blade pivot point." This feature is directly opposite the feature operation of Brown. In Brown, the plate 3 moves back and forth and no portion remains in the fixed position. Indeed, what the Examiner refers to as "the plunger" is required to move with

respect to the blade pivot point, and does not stay in fixed position from the blade pivot point. Applicant does not accept that plate 3 is a plunger or has a plunger; even if it were a plunger, it does not have the claimed feature. It is this movement of the plate 3 which transmits the spring force, quite different from the plunger and spring arrangement of the present arrangement. Claim 45 therefore embodies the concept in which the spring is a component which is physically separate from the plunger rather than venerable construction as is required in Figures 1 and 3 of Brown. Claim 45 is therefore patentable over the prior art of record.

Claim 52 is patentable because the biasing is claimed in means-plus-function format. Applicant requests that a “biasing means for holding the blade...” is to be interpreted under 112, paragraph 6 for both validity and infringement. Based on *In re Donaldson*, this claim covers the embodiments disclosed in the specification and equivalents thereof. Of course, the structure of Brown is markedly different from the structure of the biasing means as disclosed in the application as filed. Nor is the structure of Brown equivalent. As can be seen, Brown uses a solid flat plate 3 coupled to a rectangular spring. This is markedly different from the biasing means of the present invention, which includes a coil spring positioned around the plunger. Indeed, the means-plus-function language of claim 52 has full support in the application as filed, an enabling disclosure of written description was provided and also does not recapture any matter which was given up. Claim 52 should therefore be allowed on the basis of *In re Donaldson* and the means-plus-function formatting of the claim element.

Claim 58 has a particular claim element which provides an advantage beyond any prior art cited by the Examiner and any known art of record. Claim 58 specifies that a contact pin is coupled to the blade. This is the pin 63' of the application as filed, as shown in Figure 8B. The Examiner has stated that a user should be able to place their thumbnail in the clip as shown in Figure 1 of Brown and overcome the spring force to open the knife. Applicant disagrees. It is applicant's experience that most knife users have relatively short thumbnails and fingernails. Indeed, a thumbnail or fingernail, even if sufficiently long to be pressed into the clip, will usually not have sufficient strength to open the knife. If the thumbnail was sufficiently long to press into the clip and begin to open the knife, there is a high likelihood that using the thumbnail will cause pain to the user or may bend the thumbnail. On the other hand, a pin 63' may be easily pressed

open by the thumb of a user. Pushing the blade with a thumbnail is much more difficult than grasping the blade with the thumbnail and pulling it out. Grasping a blade and pulling is common; pushing is not. The pin is believed to be an additional feature which provides further benefit in opening the knife and an additional reason for patentability beyond the patentability of claim 58.

Claim 62 contains a particular element which is neither found in nor obvious from Brown. Claim 62 specifies that the biasing element, including the spring, applies “a closing force to the blade when the blade is in the retracted position;”. This feature, of the spring providing a closing force is directly opposite that of Brown. In Brown, the spring 8 is in either a neutral position or in a retained position. In either position, the spring 8 is not providing any biasing force on the blade.

This can be seen by viewing Figure 1 of Brown. The plate 3 is pressed against pins 12 and 14. The outermost edges of the apertures 6 and 5 are pressed against the pins 12 and 11. This indicates that these two pins are holding the force of the spring and that the pin 13 of the blade does not have any spring force applied thereto. Indeed, if the spring 13 of Brown had a force applied thereto, the Figures would show that the plate 3 having the spring would not rest on members 12 and 11 since it would be resting on pin 13. In Brown, when the knife is closed, the spring is exerting no force onto the blade. The biasing element does not apply a holding or pressing force to the blade when the blade is in the retracted position. Having a pressing force when closed is a unique feature which was provided in the present invention and is a specific benefit which was repeatedly explained in the application as filed. See, for example, the patent as issued, column 1, last few lines, and other places in the specification which state that the spring provides a closing force on the blade when it is in the fully retracted position. This feature of claim 62 is therefore not in the art and should be allowed.

Claim 63 contains the additional feature of a pin on the blade which extends perpendicular to a plane of travel of the blade such that a user holding the knife in one hand can apply an opening force to the blade with the thumb or finger of the same hand. Again, this feature is patentable over the prior art and contains elements not found therein. In addition, claim 63 specifies that the biasing element is coupled at a first end by a first coupling element to

the handle and a second coupling element pivotally couples the second of the biasing elements to the blade. This feature is also not found in the prior art, and the claim should be patentable thereover.

Applicant believes that the claims as now presented are clearly patentable over the prior art and request allowance thereof.

Response to Recapture Rejection Under 35 U.S.C. § 251

Applicant believes that the present claims are not an improper recapture of subject matter given up while the application was pending. The existence of a plunger and a spring was present in claim 1 as originally filed. This is the feature which has been removed from the current claims. This is the subject matter which was initially claimed more narrowly than applicant had a right to claim. Original claim 1 contained the limitation of “a spring-biased plunger carried in the blade cavity.” It also contained the additional limitation of the second end of the plunger being pivotally connected to a first end of the blade for orbital movement about the blade pivot. These were limitations in the claim as originally filed, and were more narrow than applicant had a right to claim. Applicant has submitted additional claims which are more narrow in specific elements than the claims as originally filed and the claims as amended and argued.

In the prior response, applicant provided a citation to a number of cases in an explanation why the present claims do not constitute recapture and this reissue is not an attempt to claim subject matter which was surrendered in the application during prosecution by amendment. Applicant therefore requests reconsideration of this issue, in light of the case law cited to the Examiner, and that the claims be allowed to issue.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Application No. 09/680,697
Reply to Office Action dated January 18, 2007

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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